



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,963	12/03/2003	Greg Moller	02-018-1	7416

7590 12/13/2006

Ormiston & McKinney, PLLC
Suite 400
802 W. Bannock
P.O. Box 298
Boise, ID 83701-0298

EXAMINER

CINTINS, IVARS C

ART UNIT	PAPER NUMBER
----------	--------------

1724

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/727,963

Applicant(s)

MOLLER ET AL.

Examiner

Ivars C. Cintins

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 3,6-8,11,12 and 14-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,9,10 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/20/2006.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Art Unit: 1724

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(f) he did not himself invent the subject matter sought to be patented.

Claims 1, 2, 4, 5, 9, 10 and 13 are again rejected under 35 U.S.C. 102(b) as being anticipated by Nikolaidis et al. (U.S. Patent No. 6,132,623; hereinafter “Nikolaidis”). As pointed out in the previous Office action, the reference discloses filtering (col. 5, line 8) a contaminant (i.e. arsenic) from wastewater (col. 2, line 65) by passing the wastewater through a moving mixture (col. 5, line 55) of sand (col. 5, line 12) and metal granules (col. 5, line 14); and this is all that is required by claims 1, 2, 4, 5 and 13. The filter media of this reference process will inherently be continuously regenerated for the same reason that Applicant's mixture of sand and iron granules functions in this manner. Also, the agitated mixture of sand and iron filings in the reference process (see col. 5, lines 12, 14 and 55) will inherently produce some iron oxide coated sand for the same reason that Applicant's mixture of sand and iron granules produces this material (see ¶ 0015, lines 9-13, of the specification).

Claims 1, 2, 4, 5, 9, 10 and 13 are rejected under 35 U.S.C. 102(f) because the Applicant did not invent the claimed subject matter. It appears that Moller alone invented the concept of continuously regenerating a reactive filter media, such as a mixture of metal granules and filter media, while simultaneously filtering contaminants from a fluid flowing through this filter media because this sole inventor is listed as the

Art Unit: 1724

inventive entity in Application Serial No. 11/171,002 (see claims 9 and 10); and therefore, the Applicant of this application (i.e. Moller and Brackney, Korus, Hart and Newcombe) did not invent the claimed subject matter.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 10 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Nikolaidis in view of Winchester et al. (U.S. Patent No. 6,200,482; hereinafter "Winchester"). As pointed out in the previous Office action, should it be held that the process of Nikolaidis does not inherently produce iron oxide coated sand, then this primary reference discloses the claimed invention with the exception of this iron oxide coated sand. Winchester teaches that iron oxide coated sand is an efficient filtering media for removing arsenic from water (see col. 2, lines 6-9). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the iron oxide coated sand of Winchester for the sand of Nikolaidis, in order to enhance the arsenic removal capability of the primary reference filtration media.

Claims 1, 2, 4, 5, 9, 10 and 13 are again provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being anticipated by claims 8 and 10 of Application Serial No. 11/171,002. As pointed out in the previous Office action, claims 1, 2, 4, 5, 9, 10 and 13 of this application do not preclude an ozone

Art Unit: 1724

oxidation treatment, these instant claims are deemed to be encompassed by claims 8 and 10 of Application Serial No. 11/171,002.

This is a provisional obviousness-type double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Applicant's arguments filed September 20, 2006 have been noted and carefully considered but are not deemed to be persuasive of patentability. Initially, it is noted that the assignee has failed to either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor

Art Unit: 1724

of the conflicting subject matter; and therefore, it is presumed that the conflicting inventions were not commonly owned at the time the invention. Also, since Moller alone is listed as the Applicant in Application Serial No. 11/171,002, it is presumed that the Applicant listed in this application (i.e. Moller et al.) did not invent the claimed subject matter.

Applicant argues, with respect to the obviousness-type double patenting, that since this application was filed before the '002 application, a patent granted on this application will most likely expire before a patent granted on the '002 application. It is pointed out, however, that a terminal disclaimer is necessary in this application not only to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent, but also to ensure common ownership of the patents throughout their term, thereby preventing possible harassment by multiple assignees.

Applicant also argues that Nikolaidis fails to disclose continuously regenerating a reactive filter media while simultaneously filtering contaminants from fluid flowing through the media. Again, this argument has been noted and carefully considered, but is not deemed to be persuasive of patentability. It is pointed out that Nikolaidis clearly teaches passing a fluid by through a "filter" (see col. 5, line 8) bed of reactive filter media (i.e. sand and iron filings), while agitating this reactive filter media (see col. 5, line 55); and this treatment step will inherently result in the simultaneous filtration and regeneration functions recited in the claims, for substantially the same reasons that Applicant's mixture of sand and iron granules (see ¶ 0015 of the specification) produces these results. The argument that the adsorption mechanism involved in this reference

Art Unit: 1724


process does not constitute filtering is not deemed to be persuasive because the reference itself refers to this treatment material as a "filter" (see col. 5, line 8).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is 571-272-1155.

The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Duane Smith, can be reached at 571-272-1166.

The centralized facsimile number for the USPTO is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Ivars C. Cintins
Primary Examiner
Art Unit 1724

I. Cintins
December 8, 2006